

REMARKS

Claims 1-15 and 31-39 are presently pending in the application. Claims 16-30 have been previously withdrawn in response to a restriction requirement. Claims 1 and 31 have been amended to clarify that the invention is adapted for dispensing tablets contained in blister packs. Support for the amendment is found in the original specification, for example beginning at page 4, line 23 and continuing through page 5, line 16. No new matter has been added by the amendments.

Claim Rejections – 35 U.S.C. § 103 – claims 1, 4-12, 31, and 33-36

The Examiner has rejected claims 1, 4-12, 31, and 33-36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,572,403 (Benaroya) in view of U.S. Patent No. 4,911,327 (Shepherd *et al.*, hereinafter “Shepherd”). The Examiner states that Benaroya discloses the apparatus (of claim 1) to effect the method (of claim 31). In relying upon Shepherd for disclosure of a blister pack or tray, the Examiner implicitly admits that Benaroya fails to teach, disclose, or suggest the blister tray recited in claims 1 and 31. The Examiner asserts that it would have been obvious to provide the dispenser with a blister tray in view of the teachings of Shepherd. Applicants respectfully traverse these rejections.

Benaroya discloses a device for dispensing tablets, capsules, and the like. The device comprises a base unit 12 having an outer circular sidewall 35. A carousel 15 is rotatably disposed within the base unit 12. A drive means 19 is operatively coupled with the carousel 15 to rotate the carousel within the base unit 12. A removable tray 16 having a plurality of bins 17 is adapted to fit within the carousel 15. The bins 17 are adapted to receive tablets 18. A top cover 13 may be placed on top of the base unit 12, capturing the carousel 15 and tray 16 within a cavity formed by the top cover 13 and base unit 12. The top cover 13 includes an access opening 21, through which the tablet 18 contained within a given bin 17 may be dispensed as the given bin 17 is rotated into alignment with the opening 21. An acoustic alarm 33 and a visual alarm display 32 are provided to alert a user of proper dosage times.

Shepherd discloses a device for providing scheduled dosages of pills. The device comprises a housing 22 adapted to receive a plurality of pill trays 32. A plurality of actuators 40

are provided, one actuator 40 for each pill tray 32. Each pill tray 32 includes a plurality of pill containing portions 60, each containing a ramped floor 62 arranged to allow a pill contained within the portion 60 to slide out of a dispensing slot 76 in an inner wall 64 of an outer package 52, such that the pill falls from the pill tray 32 into a pill hopper 44. A microprocessor is provided to control the actuators 40 to rotate the pill trays 32 into alignment with the dispensing slots 76. Once dispensed, the pill hopper 44 may be rotated away from beneath the pill trays 32 into a position where the dispensed pill is available to the user.

Claim 1 is directed to a tablet dispenser, and, as amended, recites *inter alia*:

...
a **blister tray** configured to receive a **blister pack** containing a plurality of tablets therein, the blister tray rotatably attached to the housing and moveable between a **closed position in which the blister tray is releasably contained within the cavity, and an open position in which at least a portion of the blister tray extends out of the cavity;**... (emphasis added)

Claim 31 is directed to a method for dispensing one or more tablets from a tablet dispenser, and as amended recites, *inter alia*:

...
(a) storing the **blister pack** containing the tablets in the **blister tray;**... (emphasis added)

When making a rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing a *prima facie* case of obviousness. The Examiner satisfies this burden only by showing (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, (2) a reasonable expectation of success and (3) the prior art references much teach or suggest all of the claim limitations (see MPEP 706.02(j)). The teaching or suggestion to make the claim combination and reasonable expectation of success must be found in the prior art and not from the applicant's disclosure (see MPEP 706.02(j)). Further, the mere fact that the prior art could be modified in the manner proposed by the Examiner, does not make the modification obvious unless the prior art suggests the desirability of the modification. *Ex parte Dussaud*, 7 U.S.P.Q. 2d 181, 1820 (PTO Bd. App. & Int. 1988).

Benaroya and Shepherd are not properly combinable under 35 U.S.C. § 103(a). Benaroya and Shepherd disclose two distinct, yet equally functional, alarmed devices for dispensing tablets. The Examiner has failed to identify any advantage to be realized by combining the device of Shepherd with the device of Benaroya.

However, assuming *arguendo* that Shepherd is properly combinable with Benaroya, the proposed combination fails to disclose at least the features recited in claims 1 and 31, as amended, of a blister tray and a blister pack. The proposed combination further fails to disclose the feature recited in claim 1 of the blister tray being moveable between a closed position in which the blister tray is releasably contained within the cavity, and an open position in which at least a portion of the blister tray extends out of the cavity.

The Examiner has relied upon Shepherd to disclose a blister tray and a blister pack. The Examiner specifically relies upon Shepherd at col. 1, lines 42-47. At col. 1, lines 40-47, Shepherd discloses as background to the invention:

Perhaps the most well known medication compliance dispenser is that used with oral contraceptives that must be taken daily over a predetermined period. These utilize a blister pack having an array of plastic blisters defining compartments for individual pills, with a frangible backing sheet which is successively numbered behind each compartment indicating the order in which the pills must be taken.

Shepherd thus discloses that blister packs and dispensers adapted for use with blister packs are known in the art. This is not a surprising observation, and is consistent with the disclosure of the present application, where at page 4, line 24, Applicants have noted that “[b]lister packs are generally known in the art”.

The invention of Shepherd, does not disclose, teach or suggest use of a blister pack or a blister tray. The device of Shepherd is adapted for use with tablets stored loosely within the pill containing portions 60. A blister pack would not be operable with the device of Shepherd, at least for the reason that there is no mechanism disclosed, taught, or suggested that would be capable of liberating a tablet housed within an individual blister of a blister pack.

Furthermore, with respect to claim 1, Benaroya and Shepherd, both individually and in the proposed combination, fail to disclose a blister tray which is moveable between a closed position in which the blister tray is releasably contained within a cavity, and an open position in which at least a portion of the blister tray extends out of the cavity. The removable tray 16 of Benaroya rotates within the cavity formed by the base unit 12 and the top cover 13, indexing the bins 17 into alignment with the opening 21 formed in the top cover 13. There is quite simply no movement between a first position in which the removable tray 16 is contained within the cavity, and a second position in which at least a portion of the removable tray extends out of the cavity. The removable tray 16 is disclosed to have but one operable position, within the cavity formed by the base unit 12 and top cover 13.

Though not relied upon by the Examiner to disclose a blister tray movable between a closed position in which the blister tray is releasably contained within the cavity, and an open position in which at least a portion of the blister tray extends out of the cavity, similarly to Benaroya, Shepherd also fails to disclose, teach, or suggest this feature recited in claim 1. The pill trays 32 of Shepherd each rotate relative to the housing 22, indexing the pill containing portions 60 into alignment with the dispensing opening 76. As with Benaroya, there is simply no movement between a first position in which the pill tray 32 is contained within a cavity, and a second position in which at least a portion of the pill tray 32 extends out of the cavity.

Neither combination nor modification of the Benaroya and Shepherd references is taught or suggested by the prior art. Even if combined, the proposed combination would fail to teach, disclose or suggest all of the elements of independent claims 1 and 31. The rejection of dependent claims 4-12 is overcome at least in view of their dependency upon claim 1 and the rejection of dependent claims 33-36 is overcome at least in view of their dependency upon claim 31. It is therefore respectfully submitted that a *prima facie* case for obviousness has not been established with respect to claims 1, 4-12, 31, and 33-36. Accordingly, it is respectfully requested that the rejection of claims 1, 4-12, 31, and 33-36 under 35 U.S.C. § 103(a) be withdrawn.

Claim Rejections – 35 U.S.C. § 103 – claims 13-15 and 37-39

The Examiner has rejected claims 13-15 and 37-39 under 35 U.S.C. § 103(a) as being unpatentable over Benaroya in view of Shepherd in further view of U.S. Patent No. 4,360,125 (Martindale *et al.*, hereinafter “Martindale”). The Examiner states that Martindale discloses a one-shot timer for an alert device, and asserts that it would have been obvious to combine the one-shot timer of Martindale with the device of Benaroya. Applicants respectfully traverse these rejections.

Martindale discloses electronic circuitry capable of being integrated into a medication dispenser. The circuitry operates to provide a medication alert signal when the medication is scheduled to be taken and a medication access signal when medication access is obtained. The circuitry further operates to record data representative of the time when the medication alert and medication access signals occur.

As noted above, Benaroya and Shepherd are not properly combinable under 35 U.S.C. § 103(a). However, assuming *arguendo* that both Shepherd and Martindale are properly combinable with Benaroya, the proposed combination fails to disclose at least the features recited in claims 1 and 31, as amended, from which the rejected claims 13-15 and 37-39 depend, respectively, of a blister tray and a blister pack. The proposed combination further fails to disclose the feature recited in claim 1 of the blister tray being moveable between a closed position in which the blister tray is releasably contained within the cavity, and an open position in which at least a portion of the blister tray extends out of the cavity. Martindale has not been relied upon by the Examiner to disclose these features, and Martindale does not disclose these features, and thus Martindale does not cure the deficiencies of the proposed combination of Benaroya and Shepherd discussed above relative to the rejection of claims 1, 4-12, 31, and 33-36.

Neither combination nor modification of the Benaroya, Shepherd, and Martindale references is taught or suggested by the prior art. Even if combined, the proposed combination would fail to teach, disclose or suggest all of the elements of claim 1, from which rejected claims 13-15 depend, or all of the elements of claim 31, from which rejected claims 37-39 depend. The rejection of dependent claims 13-15 and 37-39 is overcome at least in view of their dependency

upon claims 1 and 31, respectively. It is therefore respectfully submitted that a *prima facie* case for obviousness has not been established with respect to claims 13-15 and 37-39. Accordingly, it is respectfully requested that the rejection of claims 13-15 and 37-39 under 35 U.S.C. § 103(a) be withdrawn.

Allowable Subject Matter

Applicants acknowledge with appreciation that the Examiner has found claims 2, 3, and 32 to be allowable if rewritten in independent form. In view of the foregoing remarks, Applicant respectfully requests reconsideration of claims 2, 3, and 32 in their original dependent form.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that the Examiner's rejections have been overcome, and that the application, including claims 1-15 and 31-39, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and objections, and an early notice of allowance are respectfully requested.

Request for Interview Prior to Formal Action on Amendment

Applicants respectfully request a telephonic interview prior to formal action on this response. An "Applicant Initiated Interview Request Form" accompanies this Amendment. Please contact Applicants' attorney representative, Kerry Goodwin, at 215-965-1267 or kgoodwin@akingump.com, to schedule the interview.

Respectfully submitted,

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(Date)

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